

REMARKS

The applicants wish to thank the Examiner for her time and helpful suggestions during the telephone interview with Brandon Schurter, Dorothy Auth, and Thomas Triolo which took place on July 17, 2007. Applicants have incorporated the Examiner's suggestions into the instant application and believe that the amendments place the claims in condition for allowance. Based on the amendments and following remarks, applicants respectfully request reconsideration and withdrawal of claim rejections and allowance of this application. Favorable action by the Examiner is earnestly solicited.

Status of Claims

Claims 25-26, 36-39, 42-43, 48-51, 54-55, 58-59, and 63-74 are pending after entry of this paper. Claims 25, 26, 36-39, 42, 43, 48-51, 54, 55, 58, 59, 63, and 64 have been rejected. Claims 1-24, 27-35, 40-41, 44-47, 52-53, 56-57, and 60-62 have been cancelled without prejudice. Applicants reserve the right to pursue cancelled claims in a divisional or continuing application.

Claims 25-26, 36, 38, 48-51, 54-55, 58-59, and 63-64 have been amended.

Claim 25 has been amended to delete the phrase "a polypeptide comprising 20 or more contiguous amino acids from" and to add the phrase: "in a polypeptide comprising 20 or more contiguous amino acid of SEQ ID NO: 5." No new matter is introduced with this amendment. Support can be found throughout the instant specification, for example on page 24, lines 7-19 of the specification as filed.

Claims 26 and 63 have been amended to replace the phrase “comprising” with “consisting of”. No new matter is introduced with this amendment. Support can be found throughout the instant specification, for example: in the previously presented claims and on page 24, lines 7-19 of the specification as filed.

Claims 25 and 26 have also been amended to add the phrase “antigen-binding”. No new matter is introduced with this amendment. Support can be found throughout the instant specification, for example on page 19, lines 22-34 of the specification as filed.

Claim 63 has also been amended to replace the word “monoclonal” with “recombinant.” No new matter is introduced with this amendment. Support can be found throughout the instant specification, for example on page 24, lines 20-29 of the application as filed.

Claims 36, 38, 49, and 51 have been amended to add the words “or fragment”, “a”, and “antibody.” No new matter is introduced with this amendment. Support can be found throughout the instant specification, for example: in the previously presented claims and on page 24, lines 7-19 of the specification as filed.

Claims 54, 55, and 58-59 have been amended to add the phrase “or fragment.” No new matter is introduced with this amendment. Support can be found throughout the instant specification, for example: on page 19, lines 22-34, and page 24, lines 20-29 of the specification as filed.

Claims 48-51 and 64 have been amended to delete the word “pharmaceutical” from the preamble. No new matter is introduced with this amendment. Support can be found throughout the instant specification, for example: on page 95, line

28 – page 96, line 19, and page 103, line 16 – page 104, line 17 of the specification as filed.

Claims 65-74 have been added. No new matter is introduced with these new claims. Support can be found throughout the instant specification, for example: in the original claims and on page 95, line 28 – page 96, line 19, and page 103, line 16 – page 104, line 17 of the specification as filed.

Reconsideration and withdrawal of the pending rejections in view of the above claim amendments and following remarks are respectfully requested.

Response to Objections to the Specification

The Examiner has objected to the title of the invention for allegedly not being descriptive. Applicants respectfully disagree with the objection, however in order to expedite prosecution without disclaimer of, or prejudice to, the subject matter recited in the instant application, the applicants propose the following title: “ANTIBODIES AND COMPOSITIONS TO A RESPIRATORY DISEASE AND OBESITY RELATED PROTEIN.” Applicants believe that the new title is indicative of the invention to which the claims are directed.

The Examiner has objected to the specification for allegedly containing embedded hyperlinks and/or other forms of browser-executable code. Applicants have amended the specification to remove the hyperlinks at the lines cited by the Examiner in order to comply with the MPEP guidelines. Applicants believe that these amendments address the Examiner’s concerns regarding this objection.

The Examiner has objected to the specification for allegedly failing to comply with the Sequence rules. Applicants have amended the specification at the lines and tables cited by the Examiner in order to comply with the MPEP guidelines. Additionally, the applicants submit herewith a Sequence Listing for amino acid and DNA sequences which were disclosed in the specification as filed, but were inadvertently omitted in the original Sequence Listing that was filed with the application. Applicants believe that the amendments and Sequence Listing addresses the Examiner's concerns regarding this objection.

The Examiner has stated that "[t]he possible use of trademarks has been noted in this application." The applicants have amended the trademarks to include the proper trademark symbol (*i.e.*, either a TM or ®) following the word, in order comply with the MPEP guidelines. When possible and appropriate, the generic name for the brand name has also been provided. Applicants believe that these amendments address the Examiner's concerns regarding this objection.

Applicants respectfully request reconsideration and withdrawal of the objections to the specification in view of the above mentioned amendments and remarks.

Response to Rejections under 35 U.S.C. §112 (enablement)

Claims 48-51 and 64 stand rejected under 35 U.S.C. §112, first paragraph for allegedly lacking enablement. Specifically, the Examiner states that the instant specification allegedly provides no evidence or examples of an antibody which would be useful for treating any particular condition (Office Action, page 5). In order to expedite

prosecution without disclaimer of, or prejudice to, the subject matter recited in the instant application, the applicants have amended the claims to delete the word “pharmaceutical” from the preamble. The applicants note that, notwithstanding the amendment to claims 48-51 and 64 or the addition of new claims 65-74, these claims encompass pharmaceutical compositions. No new matter is introduced with this amendment and support can be found throughout the application as filed, for example: on page 95 (line 28) – page 96 (line 19), and page 103 (line 16) – page 104 (line 17).

Applicants assert that the application as filed enables one skilled in the art to make and use the compositions of the claimed invention. Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. §112, first paragraph rejection to claims 48-51 and 64.

Response to Rejections under 35 U.S.C. §112 (written description)

Claims 25-26, 36-39, 42-43, 58-59, 63-64 stand rejected under 35 U.S.C. §112, first paragraph for allegedly lacking adequate written description. Specifically, the Examiner takes the position that the claims do “not require the antibody to actually bind a portion of SEQ ID NO:5, but rather, the antibody could bind to anything that the protein is attached to” (Office Action, page 6). In order to expedite prosecution without disclaimer of, or prejudice to, the subject matter recited in the instant application, the applicants have amended claims 25, 26, and 63. Amended claim 25 is directed to an antibody or antigen-binding fragment that binds to “an amino acid sequence of SEQ ID NO: 5 in a polypeptide comprising 20 or more contiguous amino acid sequence of SEQ

ID NO: 5” and claims 26 and 63 are directed to an antibody which specifically binds to a polypeptide “consisting of” the amino acid sequence of SEQ ID NO: 5. Therefore, the specified antibodies and fragments must bind to the specified amino acid sequence. No new matter is introduced with this amendment. Support can be found throughout the instant specification, for example in the previously presented claims and on page 24, lines 7-19 of the application as filed.

Applicants believe that this amendment addresses the Examiner’s concerns and respectfully request reconsideration and withdrawal of the 35 U.S.C. §112, first paragraph rejection to claims 25-26, 36-39, 42-43, 58-59, 63-64.

Response to Rejections under 35 U.S.C. §102(b)

Claims 25-26, 36-39, and 63 have been rejected under 35 U.S.C. §102(b) as being anticipated by Hopp, et al. (U.S. Patent No. 5,011,912). Specifically the Examiner states that “[b]ecause the claims fail to recite indicate [sic] that the antibody binds to the polypeptide of SEQ ID NO:5, the antibody could also be binding to some other portion of the polypeptide” (Office Action, page 7) Applicants believe that the amendments that are presented and described for the “35 U.S.C. §112 (written description)” section above render this rejection moot. As discussed previously, the amended claims are directed to antibodies that bind specifically to the specified amino acid sequence of SEQ ID NO:5. None of the specified amino acid sequences include the amino acid sequence ADYKDDDDK as disclosed by Hopp, et al.

Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. §102(b) rejection to claims 25-26, 36-39, and 63.

Response to Rejections under 35 U.S.C. §102(e)

Claims 25-26, 36-39, 42-43, 58-59 and 63-64 have been rejected under 35 U.S.C. §102(e) as being anticipated by Baker, et al. (U.S. Patent Publication No. US2003/0027275). Applicants respectfully disagree with and traverse this rejection. The applicants respectfully direct the Examiner's attention to the priority date of the instant application. The instant application is a divisional of application number 09/548,797, filed on April 13, 2000 (now U.S. Patent Number 6,683,165), which claims the benefit of U.S. Provisional Application Serial No. 60/129,391, filed April 13, 1999. Therefore, the priority date of the instant application pre-dates both the publication date (*i.e.*, February 6, 2003) and the filing date (*i.e.*, June 20, 2002) of the Baker, et al. patent cited by the Examiner. Thus, applicants respectfully submit that the invention as recited in the claims as presented herein is allowable over the cited art.

Applicants believe that the priority date of the instant application addresses the Examiner's concerns and respectfully request reconsideration and withdrawal of the 35 U.S.C. §102(e) rejection to claims 25-26, 36-39, 42-43, 58-59 and 63-64.

Response to Provisional Non-Statutory Double Patenting Objection

Claim 63 and 64 have been objected to under 37 C.F.R. 1.75 for allegedly being a substantial duplicate of claim 38 and 51, respectively (Office Action, pages 4-5). Since the conflicting claims have not in fact been patented, this is a provisional double patenting objection.

In order to expedite prosecution without disclaimer of, or prejudice to, the subject matter recited in the instant application, the applicants have amended claims 63 and 64. Amended claims 63 and 64 are directed to a recombinant antibody, which is not identical to the subject matter that is claimed in claims 38 and 51. Therefore, applicants believe that this objection is rendered moot in view of the amendment to these claims. Applicants respectfully request reconsideration and withdrawal of the Non-Statutory Double Patenting Objection.

Dependent Claims

The applicants have not independently addressed all of the rejections of the dependent claims. The applicants submit that for at least similar reasons as to why independent claims 25, 26, 63 from which all of the dependent claims (*i.e.*, 36-39, 42-43, 48-51, 54-55, 58-59, and 64-74) depend are believed allowable as discussed *supra*, the dependent claims are also allowable. The applicants however, reserve the right to address any individual rejections of the dependent claims and present independent bases for allowance for the dependent claims should such be necessary or appropriate.

CONCLUSION

Based on the foregoing amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejection of claims and allowance of this application. Favorable action by the Examiner is earnestly solicited.

AUTHORIZATION

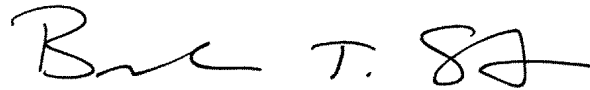
The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. **13-4500**, Order No. 2976-4039US3.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. **13-4500**, Order No. 2976-4039US3.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

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By: _____



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